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In re application of : DECISION ON
Allen et al. : PETITION
Serial No. 10/729,169 :
Filed : December 4, 2003 :
For: LOW ACTIVITATION ENERGY PHOTORESISTS

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed April 20, 2005 and made final in the office action mailed December 5, 2005.

On December 5, 2005, a restriction requirement was made between Groups I and II with the examiner's reasoning that the two were related as mutually exclusive species in an intermediate-final product relationship. The examiner stated that the intermediate product (Group I) is useful as a coating and is distinct since there is nothing on the record to show them to be obvious variants. Applicants traversed the restriction requirement in a response filed January 10, 2006. In their response, applicant argued that the groups were related as combination-subcombination, and that the claims of the combination are dependent upon the subcombination. The examiner repeated the restriction requirement in an office action mailed March 27, 2006 and made the restriction requirement final. In making the restriction final, the examiner states that the groups are separate and distinct and would place an undue burden on the examiner.

On May 31, 2006, the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are independent and distinct. Specifically, applicant argues that the examiner has not shown that the intermediate product may be used as a coating, and that the groups are related as combination-subcombination. Applicant further makes the argument that the claims are not separable as combination-subcombination.

DECISION

Sections 806.04(b) and 806.05(c) of the MPEP state in part

806.04(b)

The intermediate and final product must have a mutually exclusive species relationship and as with all species restrictions, must be patentably distinct.

Typically, the intermediate loses its identity in the final product.

Additionally, the intermediate must be shown to be useful to make other than the final product. The examiner must give an example of an alternative use but need not provide documentation. Applicant then has the burden to prove or provide a convincing argument that the intermediate does not have the suggested use.

806.05(c) Criteria of Distinctness for Combination, Subcombination, or

Element of a Combination

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search.

See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The examiner has taken the position that the groups of claims are related as intermediate - final product.

However, this does not appear to be a proper characterization of the relationship between the groups of claims.

As stated above, "Typically, the intermediate loses its identity in the final product." In the instant application, this does not appear to occur. From paragraph 00133 of the instant specification, a listing of photoacid generators is provided with the proviso that they should have high thermal stability so they are not degraded during pre-exposure processing. Based upon this, the final product of the claims is merely an admixture of the individual components claimed in claim 1 and the additional materials found in claim 47. Only upon exposure to radiation does the additive react. No evidence has been presented by the examiner that the additional components in the dependent claim would alter or destroy the components claimed in claim 1 as would be required for a holding that the groups are related as intermediate - final product. Furthermore, claim 56 is also included in Group II and is merely a polymer blend of the polymer of Group I.

The proper relationship between the two groups is Combination - Subcombination. In the instant case, the combination as claimed requires the particulars of the subcombination. Therefor, distinctness cannot be shown between the two groups and restriction is not proper.

Accordingly, the petition for withdrawal of the restriction requirement is GRANTED. Additionally, the amendment filed by Applicants on January 23, 2004 is deemed to be fully responsive and the petition under 37 CFR 1.181 is also GRANTED. The application is being forwarded to the examiner to rejoin the non-elected claims and preparing a new non-final office action addressing all pending claims.

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